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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,450	12/14/2001	Norman Muttitt	00229.0028.NPUS00	1079
22930 7590 06/25/2007 HOWREY LLP C/O IP DOCKETING DEPARTMENT 2941 FAIRVIEW PARK DR, SUITE 200 FALLS CHURCH, VA 22042-2924			EXAMINER NASH, LASHANYA RENEE	
			ART UNIT 2153	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/014,450

Applicant(s)

MUTTITT ET AL.

Examiner

LaShanya R. Nash

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

This action is in response to an Amendment filed 26 March 2006. Claims 1-31 are presented for further consideration. Claims 1, 7, 13, 19, and 25-28 are currently amended. Claims 29-31 are new.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

In considering the Applicant's argument the following factual remarks are noted:

- (I) Applicant contends that Bennett fails to disclose or suggest the generation of an individually personalized email for a patron, wherein the e-mail contains multiple pieces of content corresponding to a distinct campaign.
  
- (II) Applicant contends that Bennett fails to teach the identification of each of the patron's travel-related information and matching the multiple pieces of content to a patron's based on the patron's individual corresponding travel-related activity.

In considering (I), Applicant contends that Bennett fails to disclose or suggest the generation of an individually personalized email for a patron, wherein the e-mail contains multiple pieces of content corresponding to a distinct campaign. As further addressed in the Office action mailed 03 November 2006 (see Response to Arguments, pages 2-3), Bennett evidently teaches generating an e-mail for a patron containing

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multiple pieces of content, each piece of content corresponding to distinct campaign (i.e. e-mails for communicating combined cross-merchant campaigns to an overlapping patron; paragraph [0018], lines 8-14). Furthermore, Examiner asserts that Bennett expressly discloses individually personalizing the aforementioned e-mail for each patron. Specifically referring to an example email generated by the invention of Bennett as shown in Figure 3, the e-mail for the patron is personalized for a particular patron (i.e. Betty Schweitzer), as the e-mail comprises a personalized e-mail address of the receiving patron in the from field (Figure 3-item 48), and the e-mail content personally greets the patron by name (i.e. Dear Betty; Figure 3-item 26). Bennett also expressly discloses the advantages associated with customizing and personalizing the aforementioned emails for each patron (i.e. maximize the chance the patron will open and read the email instead of deleting it unread; Paragraph [0050], lines 8-11; paragraph [0015], line 1-paragraph [0016], lines 12), thereby further evidencing the disclosure of Bennett is directed towards individually personalized emails for each patron. Therefore, Examiner maintains the rejections as set forth below in the Office action.

In considering (II), Applicant contends that Bennett fails to teach the identification of each of the patron's travel-related information and matching the multiple pieces of content to a patron based on the patron's individual corresponding travel-related activity. Examiner notes that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in

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order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Examiner asserts that the teaching of Bennett is capable of performing the claims as recited by Applicant, as the limitations regarding "travel-related information" are merely a reference to the type of the content and does not affect the configuration nor the functionality of the invention. Bennett expressly discloses identifying each of the patron's information and matching the multiple pieces of content to a patron based on the patron's individual corresponding activity (paragraph [0036], lines 1-25; paragraphs [0067]-[0070]). The topic of the information (i.e. travel, pets, etc) has no relevance to patentability, and therefore does not support that Applicant's invention is patentably distinct over Bennett.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-2,7-8,13-14, and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Bennett et al. (US Patent Application Publication 2001/0032137), hereinafter referred to as Bennett.**

In reference to claim 1, Bennett discloses a method for distribution of targeted and highly personalized emails (abstract), which comprises:

- A method implemented by a computer for providing combining multiple pieces of content (i.e. cross-merchant marketing; paragraphs [0018], [0074]) to be provided to at least one of a plurality of patrons, (abstract and paragraph [0008], line 1 to paragraph [0009], line 21), the method comprising:
  - Identifying each of the patron's travel-related activity (i.e. patron's interest, habits, physical location; paragraph [0067], line 1-paragraph [0070], line 8);
  - Maintaining a database identifying each of the patrons and each patron's corresponding travel-related activity, (paragraph [0034], line 1 to paragraph [0036], lines 25 and paragraph [0042], lines 1-17);
  - Matching the multiple pieces of content to a patron based on each patron's individual corresponding interest, (paragraph [0066], line 1 to paragraph [0069], line 9);
  - Generating by the computer (i.e. clearinghouse; Figure 1-item 24) an individually personalized e-mail for the patrons (paragraph [0015], line 1-paragraph [0016], lines 12; Paragraph [0050], line 8-paragraph [0051], line 18), wherein the e-mail contains the multiple pieces of content (paragraph [0086]), each piece of content corresponding to a distinct campaign (i.e. cross-merchant marketing; paragraphs [0018], [0074]); and delivering the e-mail to each of the patrons, (paragraph

[0077], line 1 to paragraph [0082], line 3 and paragraph [0086], line 1 to paragraph [0088], line 12).

In reference to claim 7, Bennett discloses a system employed for distribution of targeted and highly personalized emails (abstract), which comprises:

- A system for combining multiple pieces of content (i.e. cross-merchant marketing; paragraphs [0018], [0074]) to be provided to at least one of a plurality of patrons (abstract and paragraph [0008], line 1 to paragraph [0009], line 21), the system comprising:
  - Means for (i.e. Figure 1-item 24) identifying each of the patron's travel-related activity (i.e. patron's interest, habits, physical location; paragraph [0067], line 1-paragraph [0070], line 8);
  - Means for (Figure 1-item 24) maintaining a database (Figure 1-item 23) identifying each of the patrons and each patron's corresponding travel-related activity, (paragraph [0012], lines 1-11; paragraph [0036], lines 1-25; and paragraph [0042], lines 1-17);
  - Means for (Figure 1-item 24) matching the multiple pieces of content to a patron based on each patron's individual corresponding travel-related activity, (paragraph [0066], line 1 to paragraph [0069], line 9; and paragraph [00730], line 1 to paragraph [0074], line 17);
  - Means for (Figure 1-item 24) generating an individually personalized e-mail for the patrons (paragraph [0015], line 1-paragraph [0016], lines 12; Paragraph [0050], line 8-paragraph [0051], line 18; Figure 1-item

27), wherein the e-mail contains the multiple pieces of content (paragraph [0086]), each piece of content corresponding to a distinct campaign (i.e. cross-merchant marketing; paragraphs [0018], [0074]); and

- Means for delivering the e-mail to the patron, (paragraph [0077], line 1 to paragraph [0082], line 3 and paragraph [0086], line 1 to paragraph [0088], line 12).

In reference to claim 13, Bennett discloses a system employed for distribution of targeted and highly personalized emails (abstract), which comprises:

- A system for combining multiple pieces of content in an individually personalized e-mail, (i.e. cross-merchant marketing; paragraphs [0018], [0074]), (abstract; paragraph [0008], line 1 to paragraph [0009], line 21; and Figure 1), the system comprising:
  - A processor (Figure 1-item 24) programmed to:
    - Identifying each of a plurality of patrons and each patron's corresponding travel-related activity (i.e. patron's interest, habits, physical location; paragraph [0067], line 1-paragraph [0070], line 8);
    - Maintain a database (Figure 1-item 23) identifying each of a plurality of patrons and each patron's corresponding travel-related activity, (paragraph [0066], line 1 to paragraph [0069], line 9; and paragraph [00730], line 1 to paragraph [0074], line 17);



- Match the multiple pieces of content to each of the patrons based on each patron's individual corresponding travel-related activity, (paragraph [0066], line 1 to paragraph [0069], line 9; and paragraph [00730], line 1 to paragraph [0074], line 17);
- Generate the individually personalized e-mail (paragraph [0015], line 1-paragraph [0016], lines 12; Paragraph [0050], line 8-paragraph [0051], line 18; Figure 1-item 27) for each of the patrons, wherein the e-mail contains the multiple pieces of content (paragraph [0086]), each piece of content corresponding to a distinct campaign (i.e. cross-merchant marketing; paragraphs [0018], [0074]); and a subsystem programmed to deliver the e-mail to each of the patrons, (paragraph [0077], line 1 to paragraph [0082], line 3 and paragraph [0086], line 1 to paragraph [0088], line 12).

In reference to claim 19, Bennett discloses a system employed for distribution of targeted and highly personalized emails (abstract), which comprises:

- A system for combining multiple pieces of content in an e-mail, (i.e. cross-merchant marketing; paragraphs [0018], [0074]), (abstract; paragraph [0008], line 1 to paragraph [0009], line 21; and Figure 10), the system comprising:
- A content management subsystem (i.e. Figure 10 items 23 and 232; main database and ready contact), wherein the content management subsystem is

adapted to receive content as input and is adapted to deploy the content into a first database, (paragraph [0091], lines 1-9);

- A datamart subsystem (i.e. Figure 10-item 244; campaign filter), wherein the datamart subsystem is adapted to extract content from the first database (Figure 10-item 23) and one or more other databases (Figure 10-item 238 and 240) and is adapted to match a plurality of patrons to a single piece of content, based on each patron's corresponding travel-related activity (i.e. patron's interest, habits, physical location; paragraph [0067], line 1-paragraph [0070], line 8), (paragraph [0091], lines 9-16);
- A targeted e-mail application subsystem (i.e. Figure 10-item 244; campaign filter), wherein the targeted e-mail application subsystem is adapted to merge each single piece of content matched to each of the plurality of patrons, so as to provide individually personalized target emails (paragraph [0015], line 1-paragraph [0016], lines 12; Paragraph [0050], line 8-paragraph [0051], line 18; paragraph [0086]), each targeting e-mail having multiple pieces of content for each of the plurality of patrons, (paragraph [0091], lines 9-16), each piece of content corresponding to a distinct campaign (i.e. cross-merchant marketing; paragraphs [0018], [0074]); and
- An e-mail vendor subsystem (Figure 10-item 230; e-mail send queue), wherein the e-mail vendor subsystem is adapted to distribute a targeted e-mail to each of the plurality of patrons, (paragraph [0091], lines 16-35).

In reference to claims 2,8,14, and 20 Bennett shows the target e-mail method and system further comprising prioritizing the multiple pieces of content for placement (i.e. merging) in the e-mail, (paragraph [0086]).

In reference to claims 25 and 27, Bennett shows the method and system comprises maintaining a database identifying each of the patron's travel-related behavior (i.e. information storage unit in communication with patron identification device; paragraphs [0037]-[0038]); and the matching further comprising matching the multiple pieces of content to each of the patrons based on the patron's travel-related behavior, (paragraphs [0054]-[0073]).

In reference to claims 26, Bennett shows the method wherein the behavior identified includes at least one of flight behavior and website behavior, (i.e. merchant website paragraph [0037]; paragraphs [0054]-[0073]).

In reference to claim 28, Bennett shows the system wherein the datamart subsystem is further adapted to match a plurality of patrons to a single piece of content based on patrons' travel related behavior, (paragraphs [0054]-[0073]).

In reference to claim 29, Bennett shows the method further comprising the step of analyzing each of the patron's travel-related activity (paragraphs [0073]-[0074]).

In reference to claim 30, Bennett shows the method wherein the travel-related activity is provided by the patron (paragraphs [0040]-[0042]).

In reference to claim 31, Bennett shows the method wherein the travel-related activity includes at least one of flight behavior, website behavior and program status (paragraphs [0067]-[0070]).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3-4, 9-10, 15-16 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett as applied to claims 1,7,13, and 19 above, in view of Mindrum (US Patent 4,723,212), hereinafter referred to as Mindrum.**

In reference to claims 3,9,15, and 21 although Bennett shows substantial features of the claimed invention, the reference fails to show the target email method and system further comprising limiting the number of pieces of content to be provided in the e-mail. However, this limitation was well known in the art at the time of the invention, as further evidenced by Mindrum. Therefore it would have been an obvious to one of

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ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett.

In an analogous art, Mindrum discloses a method for electronically dispensing merchant provided content (i.e. coupon), wherein the number of coupons per transaction is limited, (abstract). One of ordinary skill in the art would have been so motivated to implement this modification so as to raise the potential for creating new customers, and thereby increasing system effectiveness for merchants, (Mindrum column 1, lines 60-65).

In reference to claims 4, 10, 16, and 22 Bennett shows the target e-mail method and system, further comprising eliminating duplicate pieces of content, (paragraph [0042], lines 1-13).

**Claims 5, 11, 17 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett as applied to claims 1, 7, 13, and 19 above, in view of Kamakura (US Patent 6076101), hereinafter referred to as Kamakura.**

In reference to claims 5, 11, and 23 although Bennett shows substantial features of the claimed invention, the reference fails to show the target email method and system further comprising sorting the multiple pieces of content into defined categories. However, this limitation would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett, as further evidenced by Kamakura.

In an analogous art, Kamakura discloses an electronic mail processing method and system that generates consumer-interest based target emails, wherein the email content is organized into defined categories, (column 4, lines 37-51). One of ordinary skill in the art would have been so motivated to implement this modification so as to improve the organizational arrangement of targeted email content, and thereby increasing system ease of use for consumers/email recipients, (Kamakura column 1, lines 57-60).

**Claims 6,12,18, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of Kamakura (US Patent 6076101), hereinafter referred to as Kamakura, and further in view of Mindrum.**

In reference to claims 6,12, and 24 although Bennett shows substantial features of the claimed invention, the reference fails to show the target email method and system further comprising sorting the multiple pieces of content into defined categories. However, this limitation would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett, as further evidenced by Kamakura.

In an analogous art, Kamakura discloses an electronic mail processing method and system that generates consumer-interest based target emails, wherein the email content is organized into defined categories, (column 4, lines 37-51). One of ordinary skill in the art would have been so motivated to implement this modification so as to improve the organizational arrangement of targeted email content, and thereby

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increasing system ease of use for consumers/email recipients, (Kamakura column 1, lines 57-60). Bennett and Kamakura fail to show limiting number of pieces of content within the e-mail categories. However, this limitation was well known in the art at the time of the invention, as further evidenced by Mindrum. Therefore it would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett and Kamakura.

In another analogous art, Mindrum discloses a method for electronically dispensing merchant provided content (i.e. coupon), wherein the number of coupons per transaction is limited, (abstract). One of ordinary skill in the art would have been so motivated to implement this modification so as to raise the potential for creating new customers, and thereby increasing system effectiveness for merchants, (Mindrum column 1, lines 60-65).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R Nash whose telephone number is (571) 272-3957. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LaShanya Nash  
Art Unit, 2153  
June 12, 2007



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